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Request for Rehearing page 1 of 5
09/751,609DOCKET NO. 3066.001
FETP: 73522IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: TRAYLOR, Marc

Serial No.: 09/751,609

Filed: December 28, 2000

For: RESILIENT MAGNETIC PAINT
BRUSH HOLDER

Art Unit: 3632

Examiner: Szumny, Jonathon A.

CERTIFICATE OF TRANSMISSION/MAILING

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCESREQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52(a)(1)Mail Stop APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits this request for rehearing under
37 CFR § 41.52(a)(1) in response to the Decision on Appeal.

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Points believed to have been misapprehended or overlooked by the Board

(1) Factual support exists in the record for the interpretation of the word "bendable" in Nagy;

(2) The claim language specifies the magnitude of the claimed force constant and the displacement; and

(3) No motivation exists in Nagy to optimize the acceleration of the paintbrush.

Argument

(1) Factual support exists in the record for the interpretation of the word "bendable" in Nagy

The Decision on Appeal alleges on page 3 that there is no factual support for interpreting the word "bendable" as used in Nagy to mean a permanent deformation. However, in the Reply Brief filed on June 9, 2004, Appellant provided factual support for the interpretation of the word "bendable" in Nagy at column 2, lines 44-46, in which Nagy describes the bendable strap as follows:

"This strap is bent upon itself between its ends as at 22 to provide an upstanding vertically disposable leg 24 and an adapter bracket 26."

Clearly Nagy uses the word "bendable" to describe the permanent deformation of the flat-faced metal strap that is bent to form a bracket; that is, the strap does not revert to

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its original shape when the bending force is removed.

On the other hand, no factual basis has been presented by the rejection for redefining "bendable" in Nagy as equivalent to "resilient" as recited in Claim 1 and used the specification, for example, on page 7, lines 14-22, to differentiate between a spring and a rigid bracket. The ordinary meaning of the word "resilient" according to Webster's Dictionary is "capable of withstanding shock without permanent deformation or rupture", which is consistent with the description of the spring in the specification and distinguishes from the permanently deformed rigid bracket described by Nagy.

Because the word "bendable" in Nagy clearly refers to the permanent deformation of a metal strap bent upon itself to form a bracket, the PTO's interpretation of the word "bendable" in the context of Nagy contradicts the ordinary meaning of the word "resilient" recited in the claims.

(2) The claim language specifies the magnitude of the claimed force constant and the displacement

The Decision on Appeal alleges on page 4 that the claim language does not specify a magnitude for the claimed force constant or a displacement. However, Claim 1 recites "a force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet". The inclusion of the term "selected" qualifies the magnitude of the force constant as a deliberate choice considerate of the mechanical shock. As Appellant pointed out in the Reply Brief, the rejection does not consider the selection of the claimed resilient member, which includes the

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claimed force constant, in the claimed invention as a whole. As admitted by the Examiner's Answer on page 9, Nagy does not even recognize the need to mechanically isolate the paintbrush (10) from the can (6). Because the rejection fails to consider the invention as a whole, the rejection fails to meet the requirements of MPEP § 2141.02 to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103. Appellant respectfully requests that the Board consider all the claim limitations, including the term "selected", in interpreting the claimed force constant.

(3) No motivation exists in Nagy to optimize the acceleration of the paintbrush

The Decision on Appeal alleges on page 5 that it would be obvious for one of ordinary skill in the art to determine the design of the resilient member that optimizes the acceleration of the paintbrush. However, Appellant points out in the Reply Brief that the Examiner's Answer admits on page 9 that Nagy does not even recognize the need to mechanically isolate the paintbrush (10) from the can (6). Because the PTO admits that Nagy does not recognize the need for mechanical isolation, there is no motivation in Nagy to make a design choice to optimize the acceleration of the paintbrush. Because there is no motivation in Nagy to make a design choice to optimize the acceleration of the paintbrush, Appellant submits that the rejection relies on hindsight gleaned solely from Appellant's disclosure to select the claimed force constant of 0.75 g recited in Claim 10 as a design choice to optimize the acceleration of the paintbrush.

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For the reasons explained above, in the Appeal Brief, and in the Reply Brief, Appellant respectfully requests a rehearing to consider each of the above points.

Respectfully submitted,


Eric James Whitesell

Reg. No. 38,657

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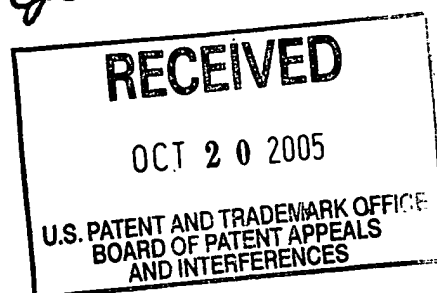
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Today's Date: September 29, 2005
From: Eric J. Whitesell, Reg. No. 38,657 *EJW*
Application No.: 09/751,609
Filing Date: December 28, 2000
Inventor: Taylor, Marc
Group Art Unit: 3632
Examiner: Szumny, Jonathon A.
Customer No. 26375
Confirmation No. 8543



Attorney Docket No.: 3066.001 (73522/7335)
Pages: 7 (including this 1-page coversheet)
Dispatched by: Julie Freiburger

Transmitted herewith via facsimile:

Transmittal (1 pg.);
Request for Rehearing Under 37 C.F.R. § 41.52(a)(1) (5 pgs.)

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	Filing Date	12/28/2000	
	First Named Inventor	TRAYLOR, Marc.	
	Art Unit	3832	
	Examiner Name	Szumny, Jonathan A.	
Total Number of Pages in This Submission	7	Attorney Docket Number	3065.001 (73522/7335)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm name	Sinsheimer, Schiebelhut & Baggett		
Signature			
Printed Name	Eric J. Whitesell		
Date	September 29, 2005	Reg No.	38,657

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